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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,654	12/21/2000	Michael Hannington	AVERP2850US	7505

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/742,654

Applicant(s)

HANNINGTON, MICHAEL

Examiner

Victor S Chang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 06 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 27-29, 32-52.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

NOTE

1. With respect to Applicant's statement "The title and the abstract have been amended to reflect more accurately the claimed invention. The invention specified in claims 27-29 and 32-52 is not limited to an adhesive article which provides air egress, but rather relates to an adhesive article which provides one or more of air egress, repositionability and slideability for easy application to a substrate; see paragraphs [0008] and [0019] of Applicant's specification. The amended title and abstract take this into account." (Remarks, page 7, second paragraph), the Examiner repeats (see Office action dated 10/5/2004, page 6, top paragraph) that the adhesive articles in paragraphs [0008] and [0019] of the specification are clearly directed to various distinct inventions. For example, the previously cancelled claims 53-95 are clearly directed to structurally distinct inventions for adhesive articles having repositionability and slidability, because the non-adhesive material forms in claims 53-95 are claimed to be flush or protruded (relative to the outer surface of the adhesive layer), which prevent/reduce contact between the adhesive surface and the substrate, and provides repositionability and slideability. In the contrary, the instant invention in independent claim 27 is directed to non-adhesive material forms with a recessed outer surface (relative to the adhesive outer surface, as shown in Figure 4a.) As such, claim 27 does not provide a means to prevent/reduce the contact between the adhesive surface and the substrate for repositionability and slideability, and claim 27 appears to be directed for air egress application only. Finally, based upon the aforementioned reasoning, the Examiner

notes that the proposed amendments to Title and Abstract appear to be not commensurate with independent claim 27, and inappropriate.

2. With respect to Applicant's argument "Paragraph [0038] of the specification supports claim 28. Paragraph [0038] states: "In one embodiment, the non-adhesive layer is a printing ink having a thickness from about 0.3 to about 100 microns ... the non-adhesive material may also be applied to the pressure sensitive adhesive by means of vacuum metallization or sputtering. In this embodiment, the non-adhesive layer typically has a thickness from about 30 to about 3000 ... nanometers" ... Thus, claim 28 ... is clearly supported by paragraph [0038]" (Remarks, pages 7-8 bridging paragraph), the Examiner would like to remind Applicant that vacuum metallization and sputtering are forming surface deposition without applying positive pressure to embed a coating, i.e., while these surface coating methods may be suitable for forming protruded coating, it is unlikely a recessed coating of claim 27 can be formed by metallization and sputtering, as evidenced by Applicant's own argument "The embodiment in which the bottom surfaces of the non-adhesive material forms are above the plane of the lower surface of the adhesive layer is described in paragraph 54, page 16 of the specification ... the non-adhesive material forms are simultaneous printed and embedded by ... flexographic printing. This printing technique embeds the print into the soft surface of the adhesive. The non-adhesive material forms are pushed into the adhesive so that a channel is formed in the adhesive ... claims 27 ... is fully supported in the specification (Remarks dated 12/3/2002, page 4, first full paragraph). As such, the Examiner notes that while paragraph [0038] provides suitable thickness ranges for non-adhesive

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material forms by various methods, only the printing method, as argued by Applicant, is able to provide a means to "push" them into the soft surface of the adhesive, and paragraph [0038] clearly states that the thickness of the non-adhesive forms by printing is from about 0.3 to about 100 microns, Applicant's argument to the contrary notwithstanding.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vsc

Victor S Chang
Examiner
Art Unit 1771

12/22/04


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